

## REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action, dated August 9, 2005.

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed.

The Examiner has rejected claims 1 to 65 as being unpatentable over Landry (US 5,649,117) in view of Kasabach (US 6,456,749).

As stated in MPEP 2143:

*To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*

The Applicant respectfully submits that there is no motivation for a person skilled in the art to combine Landry with Kasabach, and in any event, if the references are combined, the present claim 1 is patentable over Landry, Kasabach, and a combination thereof.

MPEP 2143.01 states that there are three possible criteria that should be met in order to be able to combine references. These are "the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art" (in reference to *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)).

The Applicant respectfully submits that Landry and Kasabach are directed to two completely different problems. Landry describes a bill processing and payment system, which automatically tracts, pays and reports bills for a plurality of individual payees without requiring action from the payors (see column 6, lines 55 to 60). In contrast, Kasabach describes a device for recording writings and drawings adapted to a surface, by a user, where the device is able to transmit the data to a remote device (see column 2, lines 1 to 5).

Accordingly, a person skilled in the art would not combine the references as there is no teaching, suggestion or motivation in either of the cited prior art documents to combine the two teachings. In particular, Landry and Kasabach teach away from each other as Landry only describes printing bills (see column 7, lines 12 to 15), and there is no description in Landry of the printed bills being written on, whereas Kasabach describes recording writings and drawings adapted to a surface.

In any event, even if the references were combined, the Applicant respectfully submits that the present application is patentable over the combination.

With respect to Landry, the Examiner has stated that "Landry discloses the invention substantially as claimed" (page 2, Office Action). However, the Applicant respectfully submits that the Applicant fails to see any relation between the present application, and Landry. As stated by the Examiner, Landry does not describe printing a form containing information relating to a bill paying transaction and an identity, where the form includes

coded data indicative of the identity and of at least one reference point of the form, the at least some of the coded data being coincident with the information.

Additionally, Landry does not describe receiving indicating data from a sensing device operated by the user, the indicating data being indicative of an identity of the form and of a position of the sensing device relative to the form, the indicating data having been generated by the sensing device using at least some of the coded data it sensed, and identifying from the indicating data, at least one parameter relating to the bill paying transaction.

Referring to Kasabach, Kasabach describes an invention which "provides the advantage in that it permits data entry with a hand-held device which does not require a special writing surface" (see column 2, lines 13 to 15). Hence, in order to determine the position of the hand-held device, Kasabach requires a writing surface position indicator 14, which may be in the form of a clip (see figure 3), where the writing surface position indicator 14 provides information indicative of the relative position of the writing tip 16 to the surface on which the user is using the hand-held device (see column 3, lines 8 to 50).

In contrast, the present claim 1 describes a printed form having information relating to a bill paying transaction, and coded data. The coded data is indicative of the identity of the form and of at least one reference point of the form, where at least some of the coded data is coincident with the information.

Claim 1 further describes receiving indicating data from a sensing device operated by the user, where the indicating data is indicative of an identity of the form, and a position of the sensing device relative to the form. The indicating data is generated by the sensing device using at least some of the coded data

Therefore, as Kasabach describes, the advantage of the Kasabach invention is that the invention allows data entry with a hand-held device which does not require a special writing surface, Kasabach does not describe a surface having coded data, where the coded data is coincident with bill paying information, and the coded data is able to be sensed by a sensing device. Furthermore, Kasabach does not describe coded data being indicative of the identity of the form, or at least one reference point of the form.

The Applicant respectfully submits that MPEP 2143.03 requires all of the claim limitations to be taught or suggested in the references in order to establish a *prima facie* case of obviousness. However, neither Landry, nor Kasabach nor a combination thereof describe a printed form having coded data indicative of the identity of the form and of at least one reference point of the form, where at least some of the coded data is coincident with bill paying transaction information.

Therefore, as there is no suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combining reference teachings, and furthermore, as there is no reasonable expectation of success and the prior art references do not teach or suggest all the claim limitations, claim 1 is patentable over the cited prior art.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicant:



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